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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/787,190	06/19/2001	Thomas Gassenmeier	H3486 PCT/US	7590

23657 7590 05/20/2003

COGNIS CORPORATION
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EXAMINER

YU, GINA C

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 05/20/2003

17

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/787,190

Applicant(s)

GASSENMEIER ET AL.

Examiner

Gina C. Yu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 February 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 3, 2003 has been entered. Claims 7-25 are pending.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 7-10, 13, 14, 16-20, and 23 are rejected under 35 U.S.C. 102(e) as being anticipated by over Kajino et al. (US 6099828) ("Kajino").

The broadest claims recite methods of moisturizing a substrate and hair by topically applying a composition comprising a cyclic carbonate shown in formula (I) in an oil and water emulsion; and a method of enhancing moisturizing properties of a cosmetic by adding the cyclic carbonate.

Kajino teaches water-based hair treatment compositions comprising 10 or 15 % by weight of propylene carbonate. See Tables 9, 11, and 13; instant claims 7-10, 17-20. Examiner notes that the formulations contain propylene carbonate, an oil components, which meets the limitation of instant claims.

The Kajino reference teaches that the cyclic carbonate is used as a penetration enhancer and lacks specific mention of moisturizing property of the component. Examiner however notes that the topical application of composition comprising propylene carbonate and adding the cyclic carbonate to a cosmetic composition must necessarily provide the recited moisturizing effect.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. Claims 15 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kajino, as applied to claims 7-10, 13, 14, 16-20, and 23 above.

While Kajino fails to disclose adding the additives of instant claims 15 and 24, the reference suggests using hair conditioning oil components to improve hair feel. See col. 14, lines 65 – 67.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the illustrated compositions of Kajino by adding the additional hair conditioning oil as suggested by the reference because of the expectation of successfully producing hair cosmetics with hair conditioning effect.

2. Claims 7-9, 11, 12, 17-19, and 21, 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murase (US 4801331).

Murase teaches nail lacquer remover comprising 30-65 % by weight of solvents such as propylene carbonate and glycerin carbonate. See col. 1, lines

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41 – 49. The reference teaches that such solvents overcome the disadvantage of the prior arts “which tend to extract oils and moisture from the nails”. See col. 1, line 7 – 23. Murase further teaches that the carbonates used in the invention “already have a high degree of wettability”, therefore does not requires surfactants. See col. 2, lines 44 – 52. The reference also teaches to use additives such as oils or humectants may be added in the invention. See col. 2, lines 53 – 54. See instant claims 15 and 24.

While Murase does not explicitly teach cyclic carbonates recited in instant claims 11 and 21, examiner notes that a compound having formula I having CH_2OH at R^2 and methyl group at R^1 is a homologue of glycerine carbonate. It is well known in the art that a prima facie case of obviousness may be made when chemical compounds have very close structural similarities and similar utilities. See MPEP 2144.98. Thus, examiner takes the position that the teaching of glycerine carbonate in Murase renders obvious the method of using the compounds in instant claims 11 and 21.

Given the teaching that cyclic carbonates do not remove oils and moistures from the nails it would have been obvious to one having ordinary skill in the art at the time the invention was made would have expected that the topical application of the composition provides moisturizing properties.

3. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kajino as applied to claims 7-10, 13-20, 23, and 24, and further in view of Murase and Calello et al. (US 5993837).

Kajino fails to teach glycerine carbonate.

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While Murase fails to teach the use of glycerine carbonate for hair care, the reference teaches equivalency of propylene carbonate and glycerine carbonate.

Calello teaches compositions for strengthening solid keratinous substrates such as nails or hair. See col. 1, line 11 – col. 2, line 15. The reference teaches that propylene carbonate is a well known solvent for cosmetics for these keratinous substrates. See col. 2, line 60 – col. 3, line 5.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the method of Kajino by substituting propylene carbonate with glycerine carbonate as motivated by Murase and Calello because of the expectation of successfully producing a equivalent product for hair.

Response to Arguments

Applicant's arguments with respect to claims 7-25 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 703-308-3951.

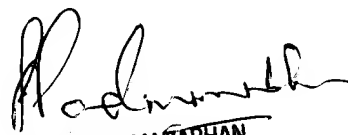
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 703-305-1877. The fax phone numbers for the organization where this application or proceeding

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is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

Gina C. Yu
Patent Examiner
May 12, 2003


SREENI PADMANABHAN
PRIMARY EXAMINER

5/18/03